



Attorney Docket: 443-17

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT: Masaaki Yamanaka et al. **EXAMINER:** Kruer, Kevin R.
SERIAL NO.: 08/855,905 **GROUP ART UNIT:** 1794
FILED: May 14, 1997 **DATED:** January 17, 2008
FOR: SYNTHETIC PAPER MADE OF
STRETCHED POLYPROPYLENE FILM

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. §41.41, please enter and consider the following Reply Brief the Examiner's Answer mailed November 20, 2007 by the Patent and Trademark Office in the above-identified application. Reference will be made to the various passages in the Examiner's Answer. The following points will be explicitly addressed:

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope addressed to Mail Stop APPEAL BRIEF-PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Dated: January 17, 2008


Leo G. Lenna

I. The Examiner's contention that it would have been obvious to "*alter*" Takashi so as to achieve an opacity of at least 80% is fundamentally flawed.

In the second full paragraph on page 5 of the Examiner's Answer, it is stated:

With regard to the opacity limitation of claim 1, Takashi does not teach the desired level of opacity of a synthetic paper. However, Ohba teaches synthetic paper comprising a polyolefin matrix tilled with inorganic filler, wherein the opacity of the film is desirably at least 80% (abstract) because such an opacity is sufficient for writing with a pencil (col. 1, lines 6-12). Therefore, the examiner takes the position that it would have been obvious to one of ordinary skill in the art to alter the opacity of the film taught in Takashi so its above 80% because such an opacity is sufficient for writing with a pencil.

However, Ohba does not teach or suggest how one skilled in the art would *alter* the components of a composition described in Takashi so as to arrive at a the desired opacity set forth in claim 1 of the present invention. In other words, Ohba does not describe what elements would need to be included in or what would have to be done to a composition in order to arrive at a composition having the claimed opacity. Instead, one skilled in the art would have to conduct undue experimentation (like the appellants have done) on different compositions and/or subjecting different compositions to various conditions and processes (i.e. temperature/stretch) in an effort to determine which combinations provide the claimed opacity. In essence, Ohba does not provide any direction and/or guidance on how to manipulate the compositions described in Takashi so as to achieve the claimed opacity. For at least these reasons, it is not obvious on how to "alter the opacity of the film taught in Takashi so its above 80%" as the Examiner contends. Accordingly, it would not have been

obvious for one skilled in the art to alter the synthetic paper in Takashi in order to achieve an opacity of 80%.

II. It would NOT have been obvious one skilled in the art to use polyetheresteramides in the synthetic paper of Takashi since it was well known that polyetheresteramides have poor heat resistance, poor compatibility with thermoplastic resins, and in no way exhibit well balanced antistatic properties.

In the Examiner's answer at page 6, first paragraph the Examiner contends that

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the antistatic agent taught in Ueda in the synthetic paper taught in Takashi because the polyetheresteramide is known to be compatible with polypropylene, heat resistance, maintains its antistatic properties permanently (abstract), and does not rinse away in the presence of water.

However, contrary to what the Examiner contends, one skilled in the art would not have even considered using a polyetheresteramides to provide the characteristics stated above since, as stated in Ueda at page 2, many polyetheresteramides known at the time of filing were known to have poor heat resistance, poor moldability and poor compatibility with thermoplastic resins as well as not having well-balanced antistatic properties. In view of the foregoing, one skilled in the art would not have even considered using polyetheresteramides in a thermoplastic resin to provide these characteristics and therefore without using impermissible hindsight reconstruction one skilled in the art would not have been motivated to look for Ueda so as to alter the synthetic paper of Takashi with the polyetheresteramides so as to arrive at the present invention.

Moreover, even the polyetheresteramides described in Ueda do not have sufficient compatibility with the thermoplastic resin when added alone but instead need to be combined with a vinyl polymer having particular functional groups in order to enhance compatibility. For this additional reason one skilled in the art would not have even considered using polyetheresteramides as the antistatic of choice, let alone to use them to alter the synthetic paper of Takashi to arrive at the present invention without using impermissible hindsight reconstruction.

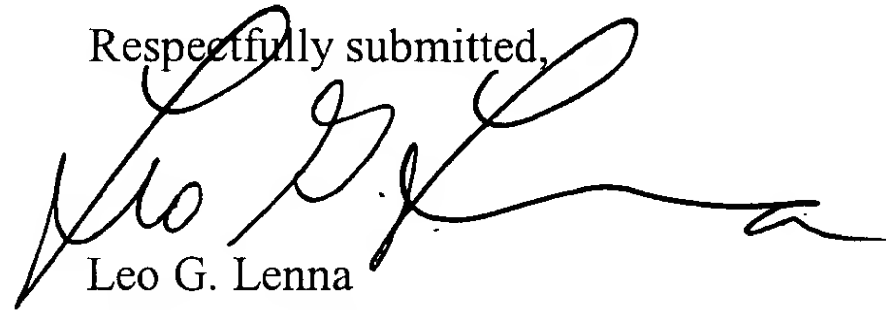
III. The Appellants's arguments with respect to "picking and choosing" from the disclosure of Ueda are **NOT** considered moot to the legal question at issue.

The Examiner's position that one skilled in the art would pick apart the synthetic paper described in Takashi and keep some components of the paper and replace other components using only certain components from Ueda and/or Ohba although other components are disclosed in these references in order to arrive at the claimed invention in and of itself is evidence of "picking and choosing." The fact remains that Ueda and Ohba contain many other components that could have been used to alter the synthetic paper of Takashi and would not have resulted in the claimed invention, but the Examiner chose to only pick the components described in these references to alter the synthetic paper of Takashi that allegedly produces the synthetic paper of the claimed invention. In doing so, the Examiner failed to take into account that one skilled in the art would not have even considered using polyetheresteramides as the antistatic of choice since it was well known that they had poor heat resistance, poor moldability and poor compatibility with thermoplastic resins and do not have well-balanced antistatic properties. Despite this fact,

the Examiner still contends that one skilled in the art would have picked the polyetheresteramides as the antistatic of choice over others disclosed in the Ueda, Ohba as well as others antistatic agents available at the time of filing. Thus, this can only be seen as “picking and choosing” as discussed in Appellants’ Appeal Brief.

Moreover, the fact that only certain elements were chosen over others also clearly constitutes evidence of improper hindsight reconstruction of the claimed invention in light of the invention disclosure found in the present application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Leo G. Lenna", written over the typed name.

Leo G. Lenna

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